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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,285	06/01/2006	Tetsuro Iwanaga	1422-0718PUS1	3178

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EXAMINER

KARPINSKI, LUKE E

ART UNIT	PAPER NUMBER
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1616

NOTIFICATION DATE	DELIVERY MODE
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10/27/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/581,285	IWANAGA ET AL.	
	Examiner	Art Unit	
	LUKE KARPINSKI	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1 and 3 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/2011 has been entered.

Claims

Claims 2 and 4-6 are canceled.

Claims 1 and 3 are pending and under consideration in this action.

Rejections

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,466,719 to Jakobson et al. in view of JP-2001-025654 utilizing the enclosed translation, herein referred to as JP'654, and USPN 5,399,357 to Akiyama et al.

Applicant Claims

Applicant claims a cleansing cosmetic comprising a fatty acid ester, a non-ionic surfactant, and an oil agent present at 10-99.8%, wherein said ester is formed from a fatty acid having 6-10 carbon atoms and a polyglycerol selected from pentadecaglycerol and eicosaglycerol and wherein said composition can form a W/O emulsion when contacted with water.

Applicant also claims 0-80% water and specific oil components.

Determination of the Scope and Content of the Prior Art ***(MPEP §2141.01)***

Jakobson et al. teach cleansing compositions (col. 10, lines 44-50) comprising mixtures of polyglycerol fatty acid esters made through the reaction of polyglycerols having a degree of polymerization of 2-8 and fatty acids having 6-14 carbon atoms (abstract), oils showing a liquid or pasty state at 25 degrees, including plant and animal oils (col. 6, lines 21-55) and said oils present at 10-60% (col. 5, lines 11-12), as pertaining to claim 1.

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Jacobson et al. further teach 0-70% water (col. 5, line 13), as pertaining to claim 3.

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

Jakobson et al. do not teach an average degree of polymerization from 15-50. This deficiency is cured by JP'654. JP'654 teaches cleansing compositions comprising a polyglycerol fatty acid ester with an average degree of polymerization of 2-16 [11].

Neither Jakobson et al. nor JP'654 teach pentadecaglycerol or eicosaglycerol. This deficiency is cured by Akiyama et al. Akiyama et al. teach that pentadecaglycerol and eicosaglycerol are polyglycerols known to be used in the formation of fatty acid ester glycerols (col. 2, lines 44-66).

Finding of prima facie Obviousness Rational and Motivation

Regarding claim 1, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of Jakobson et al. with polyglycerol fatty acid esters having an average degree of polymerization of 2-16 as taught by JP'654 in order to produce the invention of instant claim 1.

One of ordinary skill in the art would have been motivated to do this because Jakobson and JP'654 both teach cleansing compositions comprising polyglycerol fatty acid esters and teach overlapping ranges of degrees of polymerization. Therefore it would have been obvious to utilize the polyglycerol fatty acid esters of JP'654, in the

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formulations of Jakobson et al. in order to use polyglycerol fatty acid esters known to be useful in cleansing compositions.

Regarding the specific polyglycerols claimed, it would have been obvious to one of ordinary skill in the art to use either pentadecaglycerol or eicosaglycerol to form said polyglycerol fatty acid esters of Jakobson et al. and JP'654 in order to produce the formulations of claim 1.

One of ordinary skill in the art would have been motivated to do this because Jakobson and JP'654 both teach cleansing compositions comprising polyglycerol fatty acid esters, JP'654 teach polyglycerins with a degree of polymerization of 2-16 and Akiyama et al. teach that using either pentadecaglycerol or eicosaglycerol to form polyglycerol fatty acid esters was known. Therefore it would have been obvious to utilize pentadecaglycerol or eicosaglycerol to form said polyglycerol fatty acid esters of JP'654, and use these in the formulations of Jakobson et al. in order to produce polyglycerol fatty acid esters with known components to form compounds known to be useful in cleansing compositions.

Regarding the limitation of said oil component being 70% or greater, Jakobson et al. teach 60% oil and at least 10% polyglycerol, which is considered an oil component. Further, it is common practice in the art to adjust percentages of components and phases, and one of ordinary skill in the art would have been expected to modify the oil percentage to achieve the desired result.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed

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invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

2. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2003-012456 utilizing the enclosed translation, hereafter referred to as JP-456, in view of USPN 5,466,719 to Jakobson et al., USPN 5,399,357 to Akiyama et al., and JP-2001-025654 (JP-654).

Applicant Claims

Applicant claims are delineated above and incorporated herein.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

JP-456 teaches cleansing creams [1] comprising polyglycerol fatty acid esters [4], comprising polyglycerin with a degree of polymerization of three or more and fatty acids having 8-22 carbon atoms [6], and oils showing a liquid or pasty state at 25 degrees [12], as pertaining to claim 1.

JP-456 further teaches water and oils emulsions, which reads on claims 1 and 3 [1], and provides examples wherein over 70% oil component is used (page 12 and 13).

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

JP-456 does not teach percentages of both oil and water present. This deficiency is cured by Jakobson et al. Jakobson et al. teach cleansing formulations comprising 0-70% water and 10-60% oil (col. 5, lines 9-15), as pertaining to claims 1 and 3.

Neither JP-456 nor Jakobson et al. teach pentadecaglycerol or eicosaglycerol. This deficiency is cured by Akiyama et al. Akiyama et al. teach that pentadecaglycerol and eicosaglycerol are polyglycerols known to be used in the formation of fatty acid ester glycerols (col. 2, lines 44-66).

Neither JP-456 nor Jakobson et al. teach W/O emulsions. This deficiency is cured by Jp-654. JP-654 teaches that compositions comprising the same components as claimed and as taught by the combination of JP-456 and Jakobson et al. may be formulated into either a W/O or O/W emulsion as desired and one of skill would have known how to do this at the time of the instant invention ([2], [7], and [15]).

Finding of prima facie Obviousness Rational and Motivation

(MPEP 2142-2143)

Regarding claims 1 and 3, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of JP'456 with over 70% oil and 0-70% water as taught by JP'456 and Jakobson et al. in order to produce the invention of instant claims 1 and 3.

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One of ordinary skill in the art would have been motivated to do this because Jakobson and JP'456 both teach cleansing compositions comprising oil and water and Jakobson et al. teach specific percentages of said components to use and JP'456 provides examples wherein over 70% oil is used. Therefore it would have been obvious to utilize the oil percentages of JP'456 and the water percentages of Jakobson et al. in the formulations of JP'456 in order to use produce emulsion cleansing compositions with known amounts of water and oil.

Regarding the specific polyglycerols claimed, it would have been obvious to one of ordinary skill in the art to use either pentadecaglycerol or eicosaglycerol to form said polyglycerol fatty acid esters of Jakobson et al. and JP'456 in order to produce the formulations of claim 1.

One of ordinary skill in the art would have been motivated to do this because Jakobson and JP'456 both teach cleansing compositions comprising polyglycerol fatty acid esters, JP'456 teach polyglycerins with a degree of polymerization of 3 or more and Akiyama et al. teach that using either pentadecaglycerol or eicosaglycerol to form polyglycerol fatty acid esters was known. Therefore it would have been obvious to utilize pentadecaglycerol or eicosaglycerol to form said polyglycerol fatty acid esters of JP'456, and use these in the formulations of Jakobson et al. in order to produce polyglycerol fatty acid esters with known components to form compounds known to be useful in cleansing compositions.

Regarding the limitation to a W/O emulsion, it would have been obvious to one of ordinary skill in the art to formulate said compositions into W/O emulsions as well as O/W emulsions in order to produce the formulations of claim 1.

One of ordinary skill would have been motivated to do this because the combination of JP-456 and Jakobson et al. teach the same components and percentages thereof as claimed in an O/W form and JP-654 teaches that compositions comprising the same components may be formulated into either an O/W or W/O form as desired. Therefore it would have been obvious to alter the O/W emulsions of the JP-456 and Jakobson et al. combination to W/O formulations as described by JP-654 in order to produce a formulation with the desired properties and feel of a W/O emulsion.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

3. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2001-025654 utilizing the enclosed translation, herein referred to as JP'654 in view of USPN 5,399,357 to Akiyama et al.

Applicant Claims

Applicant claims are delineated above and incorporated herein.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

JP'654 teaches cleansing compositions comprising polyglycerol fatty acid esters [1], comprising fatty acids with 8-24 carbons [8], a degree of polymerization of 2-16 [11], and oils showing a liquid or pasty state at 25 degrees, including plant and animal oils [13], as pertaining to claim 1.

JP'654 further teaches water and oil mixtures comprising 0.1-98.9% of said oil component [15], as pertaining to claims 1 and 3.

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

JP'654 does not teach pentadecaglycerol or eicosaglycerol. This deficiency is cured by Akiyama et al. Akiyama et al. teach that pentadecaglycerol and eicosaglycerol are polyglycerols known to be used in the formation of fatty acid ester glycerols (col. 2, lines 44-66).

Finding of prima facie Obviousness Rational and Motivation

(MPEP 2142-2143)

Regarding the specific polyglycerols claimed, it would have been obvious to one of ordinary skill in the art to use either pentadecaglycerol or eicosaglycerol to form said polyglycerol fatty acid esters of JP'654 in order to produce the formulations of claim 1.

One of ordinary skill in the art would have been motivated to do this because JP'654 teaches cleansing compositions comprising polyglycerol fatty acid esters, JP'654 teach polyglycerins with a degree of polymerization of 2-16 and Akiyama et al. teach that using either pentadecaglycerol or eicosaglycerol to form polyglycerol fatty acid esters was known. Therefore it would have been obvious to utilize pentadecaglycerol or eicosaglycerol to form said polyglycerol fatty acid esters of JP'654, and use these in order to produce polyglycerol fatty acid esters with known components to form compounds known to be useful in cleansing compositions.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to Arguments

Applicant's arguments filed 9/18/2011 have been fully considered but they are not persuasive.

Applicant argues that Akiyama et al. is not properly combinable with the other references.

This argument is not found persuasive because Akiyama et al. is used as an evidentiary reference in order to show that pentadecaglycerol and eicosaglycerol were known polyglycerols at the time of the instant invention and that both of said glycerols

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were known to be capable of undergoing esterification with fatty acids. Jakobson et al. teach that an object of the invention is to provide polyglycerol fatty acid esters. Jakobson et al. also teach that polyglycerols in general are esterified with fatty acid esters to produce polyglycerol fatty acid esters.

Applicant also argues that the maximum percentage of oil in Jakobson et al. is 60% and the amended claims now recite a lower limit of 70%.

This argument is not found persuasive because Jakobson et al teach 10-60% oil, and 10-60% polyglycerol, which is considered an oil component. Therefore Jakobson et al. teach 60% oil and at least 10% polyglycerol, which is an oil component, giving 70% oil and up.

Applicant also argues to unexpected results.

This argument is answered in the affidavit section below.

Affidavit/Declaration

The declaration under 37 CFR 1.132 filed 5/09/2011 is insufficient to overcome the rejection of claims 1 and 3 based upon the obviousness rejections as set forth in the last Office action because: the examiner is unimpressed with the confidence level of the submitted data in light of the fact that only 5 people made up the panel to give their opinion on subjective properties.

Further, the increase in affinity to makeup soils and the remover capability would have been expected to increase. An increase in said properties would have been

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expected because makeup soils are generally hydrophobic in nature and would dissolve better in high oil content compositions and this would also result in a better remover capability. Further, the rinsability may have a range of as high as 4.0 to 4.8 but said range may be as low as 4.3 to 4.4. In light of the fact that said testing is subjective and conducted by only 5 people, this difference is seen as a difference in degree and not a difference in kind. Therefore, the claim to unexpectedness is viewed as expected.

Conclusion

Claims 1 and 3 are rejected.

No claims are allowed.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on monday-friday 9-5 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616